

REMARKSDrawing Objections – 37 C.F.R. 1.84(h)(3)

Figure 2 has been corrected so that the ends of the broken line are designated by numerals (3) corresponding to the view number of the sectional view (Fig. 3). Figure 5 has been corrected such that the ends of the broken line are designated by numerals (6) corresponding to the view number of the sectional view (Fig. 6). Applicant respectfully submits that the drawings are labeled in accordance with 37 C.F.R. 1.84(h)(3) and are currently in condition for allowance. Withdrawal of the objections is respectfully requested.

Drawing Objections – 37 C.F.R. 1.84(p)(5)

Figures 2, 3, 5, 6, 7A-C, and 8A-E have been corrected to include reference characters “100” and “200” mentioned in the description. Applicant respectfully submits that the drawings are labeled in compliance with 37 C.F.R. 1.84(p)(5) and are currently in condition for allowance. Withdrawal of the objections is respectfully requested.

Specification Objections – 35 U.S.C. §132

The amendment filed March 15, 2004 stands objected to under 35 U.S.C. §132 as introducing new matter into the disclosure. Examiner asserts that the original disclosure does not support the added material found on Page 3, lines 8-14, “The grip provides a comfortable, resilient gripping surface without the use of upstanding stems, protrusions, or nibs.”

Applicant has amended the specification and believes that the objection has been overcome.

Claim Rejections – 35 U.S.C. §112

Claims 11, 23, 34, 46, 57, 69, and 74 through 79 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Examiner asserts that the Specification as originally filed fails to provide support for the newly added limitation “said top surface is characterized by an absence of upstanding stems.” Applicant has amended the claims, replacing the phrase “said top surface is characterized by an absence of upstanding stems” with “said top surface is smooth”.

Information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter. MPEP 2163.06.

Support for the added material is found in the Specification on Page 8, lines 1-2, where it states, “If skin layer 104 is formed from expanded vinyl, the vinyl surface may be smooth” Additionally, FIGS. 1-12 of the application as originally filed clearly show that the top surface is smooth. Therefore, Applicant respectfully submits that no new matter has been introduced by the amendments to the claims and that Claims 11, 23, 34, 46, 57, 69, and 74 through 79 are currently in condition for allowance. Withdrawal of the rejection is respectfully requested.

Examiner has provided no other basis for rejecting Claims 74 through 79 other than the §112 rejection discussed above. Since this rejection has been overcome by Applicant’s amendments, Applicant respectfully submits that Claims 74 through 79 must be allowed.

Claim Rejections – 35 U.S.C. §102(e)

Claims 11, 34 and 57 were previously rejected in the Office Action dated January 23, 2004 under 35 U.S.C. §102(e), as being anticipated by Kobe et al. (US 6,610,382 B1). Applicant respectfully disagrees with Examiner's contentions.

Directing Examiner's attention to MPEP 2131, the threshold issue under Section 102 is whether the Examiner has established a *prima facie* case for anticipation. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)". "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989).

Claim 11

As amended, Claim 11 of the present invention recites a grip comprising "a skin layer having a top surface and a bottom surface, said top surface is smooth; a 4-way stretchable material layer with a stretchable top surface and a stretchable bottom surface wherein said 4-way stretchable material comprises polyester, said top surface of said stretchable layer adhered permanently to said bottom surface of said skin layer; and a releasable adhesive disposed on said bottom surface of said 4-way stretchable layer."

Kobe does not teach a grip comprising a skin layer having a top surface that is smooth. As seen in Fig. 1 and the description, Kobe teaches a skin layer having a top surface with upstanding stems, stating, "The article 20 includes a backing layer 21 having a first surface 24 with an array of upstanding stems 26." (Col. 3, lines 39-42). Kobe further states that "As used herein, backing layer refers to an assembly having one or more layers supporting the upstanding stems" (Col. 4, lines 5-7). The backing

layers in Kobe require the support of upstanding stems. Since a surface with an array of upstanding stems cannot be smooth, such a requirement teaches away from the top surface being smooth as required by Claim 11 of the present invention.

Furthermore, Kobe does not teach a 4-way stretchable material with a top surface adhered permanently to the bottom surface of a skin layer and a releasable adhesive disposed on its bottom surface. In the Office Action dated January 23, 2004, Examiner asserts that the backing layer 22 acts as the 4-way stretchable material. However, in describing backing layer 22, Kobe states that it serves “to resist stretching”. (Col. 4, lines 1-2).

Although Kobe goes on to provide a vague description of polyester as a suitable backing layer (Col. 4, lines 25-41), it does not specifically teach that polyester or another potentially stretchable material can be used as the additional backing layer 22, which is positioned where the 4-way stretchable material is positioned in the present invention. Kobe states that “As used herein, backing layer refers to an assembly having one or more layers supporting the upstanding stems” (Col. 4, lines 5-7). Therefore, when Kobe vaguely describes suitable backing layer materials, its lack of description about which material should be used where fails to adequately teach a 4-way stretchable material as specific backing layer 22. The fact that Kobe specifically teaches away from using a stretchable material for backing layer 22 contradicts and far outweighs any vague suggestion that polyester and similar materials may be used somewhere in the grip’s general assembly. The additional backing layer 22 cannot be a 4-way stretchable material comprising polyester.

Applicant respectfully submits that Kobe fails to teach each and every element of the present invention and that Claim 11 is currently in condition for allowance. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

Claim 34

The same arguments made for Claim 11 above are applicable to the patentability of Claim 34 as well. Applicant respectfully submits that Kobe fails to teach each and every element of the present invention and that Claim 34 is currently in condition for allowance. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

Claim 57

The same arguments made for Claim 11 above are applicable to the patentability of Claim 57 as well. Applicant respectfully submits that Kobe fails to teach each and every element of the present invention and that Claim 57 is currently in condition for allowance. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. §103(a)

Claims 23, 46 and 69 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Kobe. Applicant respectfully disagrees with Examiner's contentions.

For a §103 obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*,

165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1996).

As mentioned above, not only does Kobe fail to teach a skin layer having a smooth top surface, but it actually teaches away from that limitation of the present invention by teaching a skin layer with a top surface having upstanding stems. Kobe also fails to adequately teach the specific placement or location of the 4-way stretchable material required by the present invention, merely providing a vague description.

Therefore, not only does Kobe fail to disclose all of the elements of the present invention, but there is no motivation or suggestion to modify it so as to arrive at the present invention. Claim 23, 46 and 69 are currently in condition for allowance. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

A handwritten signature in black ink, appearing to read 'Kenneth D'Alessandro', with a long horizontal line extending to the right.

Kenneth D'Alessandro
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Dated: September 3, 2004

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In the Drawings:

Please amend the figures as follows:

FIG. 2: Please add reference number 100 and replace reference number 103 with reference number 3 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG.3: Please add reference number 100 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG. 5: Please add reference number 200 and replace reference number 203 with reference number 6 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG.6: Please add reference number 200 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG.7A: Please add reference number 100 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG.7B: Please add reference number 100 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG.7C: Please add reference number 100 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG.8A: Please add reference number 200 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG.8B: Please add reference number 200 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG.8C: Please add reference number 200 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG.8D: Please add reference number 200 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.

FIG.8E: Please add reference number 200 as indicated in the attached Annotated Marked-Up Drawing. A replacement page is provided.